

REMARKS

This application provides for herbicidal compositions comprising at least one herbicidally active surfactants, at least one non-silicone surfactant and at least one humectant. Applicants discovered that the inventive compositions exhibit superior herbicidal activity, which may be synergistic in nature (see paragraph bridging pages 24 and 25).

This Amendment adds two claims in excess of 20 and a check for \$ 36.00 is enclosed to cover the cost of this fee. It is believed that no further fee is required for the consideration of this Amendment. If, however, an additional fee is required, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment to Deposit Account 50-0320.

Applicants thank the Examiner for indicating that claims 20 and 27 contain allowable subject matter.

This Amendment amends claims 1, 16, 24 and 30 and adds new claims 31 and 32. The amendments to claims 1 and 16 are made in order to advance prosecution, since these changes make the claims recite subject matter that the Examiner has indicated to be allowable. Applicants reserve the right to file a divisional application directed to the remaining humectants. The amendments made to claims 24 and 30 correct an obvious typographical error and do not add new matter or affect the scope of the claims.

New claims 31 and 32 find support in former claims 10 and 11. Thus, no new matter is added.

Claims 1, 3, 4, and 12 stand rejected under 3 USC §102(a) and (b) for allegedly being anticipated by any one of the following Japanese patents: JP 58-124702, JP 6-48902, or JP 11-

302116. It is urged that the amendments to the claims render this rejection moot and withdrawal is requested.

Claims 1 to 13 stand rejected under 35 USC §103(a) for allegedly being unpatentable over the combined teachings of Griffin *et al.*, US 4,44,917 ("Griffin"), Zeneca, PCT WO 96/00010 and Matsumoto *et al.* ("Matsumoto"). With respect to claims 1 to 4 and 12 to 27, it is urged that the amendments to claims 1 and 16, which recite subject matter the Examiner has found allowable, is moot and should be withdrawn. Applicants urge that as claims 12 and 13 depend from an allowable composition, they are also allowable. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1991), *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1996). With respect to claims 28 to 30, Applicants respectfully urge that Griffin does not specifically disclose any of the claimed sulfonylurea compounds contained in the composition for controlling the growth of *Bromus* plants and neither that patent nor Zeneca or Matsumoto provides any guidance to modify the compounds in this manner to arrive at the sulfonylureas of the present invention. Accordingly, reconsideration and withdrawal of the rejection with respect to these claims are requested.

Griffin does not disclose any sulfonylureas that correspond to the compounds of formula (II') let alone the fact that such compounds would be very effective against *Bromus tectorium*. In Griffin, none of the compounds possesses for example, the instant pyrimidine or triazine moiety or the instant substitutions on the phenyl ring. Zeneca or Matsumoto do not correct this deficiency as they are silent with respect to the sulfonylureas of the inventive composition. As stated by the Federal Circuit, in determining whether a case of *prima facie* obviousness exists, it is necessary to ascertain whether the prior art teaching would appear sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modifications; i.e., the prior art must provide one of ordinary skill in the art the motivation to make the claimed substitution. *In*

re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Lahu*, 233 USPQ 1257 (Fed. Cir. 1984). As none of the prior publications provides much motivation, it is urged that the rejection does not establish a *prima facie* case of obviousness. Accordingly, withdrawal of this rejection is requested.

As it is believed that this application is in condition for allowance, an early notice to that effect is requested. If, however, there remains an issue outstanding, the Examiner is invited to contact the undersigned for its prompt consideration.

Respectfully submitted,

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